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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,776	07/21/2006	Arne Ptock	12810-00326-US1	7822

23416 7590 08/19/2008
CONNOLLY BOVE LODGE & HUTZ, LLP
P O BOX 2207
WILMINGTON, DE 19899

EXAMINER	
WEBB, WALTER E	

ART UNIT	PAPER NUMBER
1612	

MAIL DATE	DELIVERY MODE
08/19/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/586,776	PTOCK ET AL.	
	Examiner	Art Unit	
	WALTER E. WEBB	1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/21/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1) Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over (DE 19935763 A1 with computer generated English Translation) and in further view of Hoppe et al, (US 4,617,390).

Jenning teaches a skin care composition comprising an oil-in-water emulsion base containing retinoid. (See Abstract.) The composition may also contain sun screening preparations. (See pg. 4, lines 24-27). They teach a water-in-oil cream

composition comprising retinol at 0.1% by weight, at least one water-soluble antioxidant (ascorbic acid) at 0.2% by weight, and at least one oil soluble antioxidants (tocopherol) at 1.0% by weight, as per claims 1-3, 5, 7, 8, 10, 12, 13, 16 and 17. (See first table at pg. 5, V2 or 1.) The water-soluble antioxidant is 2 parts by weight of the retinoid, and the oil-soluble antioxidant is 10 parts by weight of the retinoid. They teach that the retinoid is all-trans retinol (see claim 12 at pg. 9, line10-11.) The example at page 5 shows tocopherol acetate. However, the use of natural lipophilic antioxidant tocopherol maximally at 5% and especially below 0.5% of the entire emulsion is also taught. (See top of pg. 4, lines 14-18.) The natural tocopherol is referred to as "RRR-alpha tocopherol", as per claims 19 and 20. (See pg. 2 lines 40-41.) Also the ascorbic acid referred to is L-acorbic acid, as per claims 5 and 16-18. (See ibid.)

They also teach storage in aluminum tubes without air (gas), as per claim 11. (See pg. 5, lines 44-47 and Example 2, Table 1.)

Jennings does not a composition of 0.01 to 10% by weight of at least one UV filter.

Hoppe et al. teach the use of compounds that display very powerful protective action against light as well as possessing good permeability to pigment forming untraviolet-A radiation. (See col. 2, lines 1-6.) They teach that a cosmetic preparation or formulation contains in general from 0.1 to 10%, based on the weight of the formulation, of their compound.

Hoppe does not teach the instant retinoid preparation.

In would have been obvious to a person having ordinary skill in the art to add a uv filter to the composition of Jennings since Jennings teach that sun screening preparations can be added. Hoppe provides motivation for adding an amount of a uv filter within the 0.01 to 10% range, as per claim 1.

In regard to the preparation where 3 to 5 parts by weight of one or more water or oil-soluble antioxidants (claims 4, 14 and 15), the reference teaches various ranges retinol (0.01 to 0.15% by weight), ascorbic acid (0.05 to 0.8% by weight), and α-tocopherol (maximally at 5% and especially below 0.5%). The adjustment of conventional working to the preparation of Jenning, especially within the broad ranges instantly claimed is deemed a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan. Based on the teachings of Jenning, the artisan would have formulated a composition where retinol is 0.1% wt., the ascorbic acid is 0.3%, and the α-tocopherol is 0.3% satisfying the limitations of claims 4, 14 and 15, where such formulation exhibited the optimum properties necessary for a particular given application.

2) Claims 1-4, 7, 8-10 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chandar et al., (US 2002/0110572) and in further view of Hoppe et al., (*supra*).

Chandar et al. teach a cosmetic composition containing a retinoid and having improved stability and mildness. (See abstract) The retinol is preferably all-trans retinol, as per claim 7. (See [0009] at pg. 1.) The amount of retinol varies from 0.001 to

10% wt. (See [0012] at pg. 1.) They teach adding antioxidants in an amount form 0.01 to 10%. (See [0147] at pg. 12.) The specifically teach an oil-in-water composition where the retinol is 0.2%, BHT (oil-soluble antioxidant) is 0.2%, and sodium bisulfite (water-soluble antioxidant) is 0.2%, as per claims 1, 3, 8, 10 and 13. (See Table 1 at pg. 13.) They also teach the addition of sunscreens. (See [0149] at pg. 12.)

Chandar et al. do not a composition of 0.01 to 10% by weight of at least one UV filter.

Hoppe et al. teach the use of compounds that display very powerful protective action against light as well as possessing good permeability to pigment forming untraviolet-A radiation. (See col. 2, lines 1-6.) They teach that a cosmetic preparation or formulation contains in general from 0.1 to 10%, based on the weight of the formulation, of their compound.

Hoppe does not teach the instant retinoid preparation.

In would have been obvious to a person having ordinary skill in the art to add a uv filter to the composition of Chandar since Chandar teaches that adding sunscreen. Hoppe provides motivation for adding an amount of a uv filter within the 0.01 to 10% range, as per claim 1.

In regard to the preparation where 3 to 5 parts by weight of one or more water or oil-soluble antioxidants (claims 4, 14 and 15), the reference teaches various ranges retinol, water-soluble antioxidant, and oil-soluble antioxidant. The adjustment of conventional working to the preparation of Chandar, especially within the broad ranges instantly claimed is deemed a matter of judicious selection and routine optimization

which is well within the purview of the skilled artisan. Based on the teachings of Chandar, the artisan would have formulated a composition where retinol is 0.1% wt., the ascorbic acid is 0.3%, and the α-tocopherol is 0.3% satisfying the limitations of claims 4, 14 and 15, where such formulation exhibited the optimum properties necessary for a particular given application.

Nonstatutory Obvious-type Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 7, 9-13, 16, 18 and 19 of copending Application No. 10/515636 in view of Hoppe et al., (*supra*).

Both applications claim a preparation containing a retinoid, ascorbic acid and α-tocopherol in the same proportions. However, the instant claim 1 adds a UV filter. Adding a UV filter would be obvious in light of the fact that the preparations can be used cosmetically to treat the skin. The artisan would have been motivated to provide a skin care product that treats and protects the skin from sun damage. Hoppe et al. teach adding a uv-filter to cosmetic preparations or formulations in general from 0.1 to 10%, based on the weight of the formulation, of their compound. Therefore it would have been obvious to provide a uv-filter at 0.1%, for example, in the instant skin care composition, since this amount is recognized in the prior art as an effective amount for protecting the skin from sun damage.

This is a provisional obviousness-type double patenting rejection.

Conclusion

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter E. Webb whose telephone number is (571) 270-3287. The examiner can normally be reached on 8:00am-4:00pm Mon-Fri EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Walter E. Webb
/Walter E Webb/
Examiner, Art Unit 1612

/Frederick Krass/

Supervisory Patent Examiner, Art Unit 1612